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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :

Appl. No.10/625,149 : Confirm. No. 8274
H. Downman McCarty, II :
Brooke Schumm III :
Peter Popper, Applicants : Examiner: O. Flores Sanchez
Filed: July 23, 2003 : Group Art Unit 3724

**For: AN ANTI-SPALLING COMBINATION ON AN IMPACT TOOL
WITH AN IMPROVED HOLDING SYSTEM**

Honorable Commissioner of Patents and Trademarks
Mail Stop Patent Application, P.O. Box 1450
Alexandria, VA 22313-1450

CONTINUATION AND PRIORITY DATA

Continuation in part of PCT/US02/23448 and entry into the national stage of PCT/US02/23448,
continuation in part of U.S. provisional applications 60/307,198 filed on July 23, 2001, and
60/356,804 filed on February 13, 2002

**SUMMARY OF INTERVIEW
WITH SUPERVISORY PRIMARY EXAMINER AND EXAMINER OF MAY 6, 2009**

Pursuant to MPEP ¶713 and 37 CFR 1.133, Applicant submits the following interview summary:

Present in person were H. Downman McCarty II and Brooke Schumm III for the meeting scheduled at 11 a.m. The meeting took place in an otherwise empty conference room on the 7th floor of the Randolph Building.

From the PTO, present in person was Mr. Boyer Ashley, SPE. Mr. Flores Sanchez, Examiner joined the interview in person at 11:30 a.m. The interview concluded at approximately 11:45 a.m.

The "Amendment Pursuant To Examiner Interview Of May 6, 2009 To Applicants' Response To Preceding Office Action" filed electronically and by Rightfax on May 6, 2009 is adopted by reference (the "May 6 Amendment").

Because Mr. Flores Sanchez was not initially present, preliminarily, Applicant's counsel showed the invention for demonstration purpose in the form of a $\frac{1}{2}$ " cold chisel marketed by Baltimore Tool Works, Inc. The shaped polymeric material of the tool in the form of a cap prior to placement on the tool was shown for demonstration purposes.

Counsel Schumm summarized the latest Office Action and the procedural path of the case. Mr. Ashley asked to review the art cited by the Examiner, namely Jeffery, U.S. Pat 3,320,986, and Smith, U.S. Pat. 4,497,355. After that review by Mr. Ashley, Applicant pointed out that the key to the invention was the combination of the more acute angle with the reinforced polymer cap. Only because of the combination was the invention successful. Because the reinforced polymer cap was softer than the raw steel of the cold chisel, but hard enough and toughened enough by reinforcement to withstand hammer blows, the edge of the chisel could be more acute and the tool would maintain its effectiveness to cut standard $\frac{1}{4}$ " steel drill rod in testing according to the percentage set out in the claims. Citation was made to the Declaration of James Glancey, Ph.D. in the record, and Mr. Ashley read that Declaration. With respect to Smith '355, that invention as focused on lines to serve as guides to sharpen the chisel to a standard angle.

Discussion focused on the independent claims 143 and 151, particularly claim 143.

A competitive tool (described in the Declarations of Mr. McCarty and Dr. Glancey) made under the trade name GRIP (marketed Northern Tool), which by appearance looks virtually identical to the Baltimore Tool Works chisel, which is the invention, was shown to Mr. Ashley

for demonstration purposes. The cap on the GRIP tool was not reinforced but was made of a polymer. It had failed on testing as set out in the Declarations of Mr. McCarty and Dr. Glancey. That chisel would be comparable to the Jeffery design in terms of material selection.

At 11:30 a.m., the Examiner arrived, and Mr. Schumm summarized his argument. The Examiner presented an additional art from W. French, U.S. Pat. 628,455, July 11, 1899, and Kolloch, U.S. Pat. 4,133,362 that he asked Mr. Schumm to consider. Mr. Schumm reviewed them. Mr. Schumm pointed out that French '455 proposed an elastic material such as rubber. By contrast, the present invention did not use or claim an elastic material, but rather an inelastic fiber-reinforced very tough and hard material.

As to Kolloch '362, the preferred embodiment was to utilize a flexible synthetis[sic] resin for a hand guard for the chisel. Again, for this McCarty invention, flexibility of material for the shaped polymeric material was not desired and not part of the claims as it would absorb too much force. Flexibility would also be ergonomically undesirable because a worker would have to expend too many blows to accomplish the same task as a bare chisel. No handguard as shown in Kolloch '362 is present or needed in the independent claims of the McCarty invention or in the sample produced, marketed and exhibited.

Mr. Schumm referred to the Declarations and their references to the competitive GRIP® tool and the market success in penetrating the Home Depot® product line and market and long-felt need to the difficult problem of noise reduction, and vibration reduction and eliminating spalling. Mr. Schumm pointed out that the chisel in Jeffery '986 was designed to deform in order to conform in shape to the chisel head, and as a result would ultimately spall and fail, and have increased sound and vibration as the cap fatigued on the Jeffery '986 chisel. In contrast, the McCarty invention at hand operated on a different set of principles, and was designed to

maintain its shape and have no deformation after a hit. When the competitive tool was shown, the Examiner stated that the limitation of non-failure and non-deformation that would interfere with function was not present in the claims. Mr. Schumm offered to make those limitations.

Mr. Schumm confirmed that the dependent claims were allowable if the independent claims were allowable.

Mr. Schumm outlined the limiting language to be added to the claims 143 and 151, and Mr. Flores Sanchez indicated agreement that the addition of the proposed language should result in allowance of the case, and asked for the amendments to be made that day, May 6. Mr. Schumm had another item scheduled late in the afternoon but thought that would be feasible. Mr. Schumm returned to his office and made the proposed amendments, and filed the May 6 Amendment electronically on May 6, 2009 at approximately 2:10 p.m., and sent them by facsimile as requested and advised the Examiner by telephone that they had been sent.

Respectfully,

/s/ /Brooke Schumm III / _____
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Date: 5 June, 2009

I certify I caused the above to be filed electronically in the USPTO this 5th day of June, 2009 and copy to be sent by facsimile to Mr. Boyer Ashley, SPE at 571-273-8300.

/s//Brooke Schumm III/ _____

Brooke Schumm III